



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,095	09/12/2003	Richard E. Rowe	IGTIP063X1P-575CIP	6585
22434	7590	02/11/2008		
BEYER WEAVER LLP			EXAMINER	
P.O. BOX 70250			HALL, ARTHUR O	
OAKLAND, CA 94612-0250				
			ART UNIT	PAPER NUMBER
			3714	
			MAIL DATE	DELIVERY MODE
			02/11/2008 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/661,095

Applicant(s)

ROWE, RICHARD E.

Examiner

Arthur O. Hall

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Amendment

Examiner acknowledges applicant's amendment of claims 1, 15-16, 20-22, 26-28 and 41 in the Response dated 11/28/2007 to Non-final Office Action dated 6/28/2007. Claims 1-41 are pending in the application and subject to examination as part of this office action.

Examiner acknowledges that applicants arguments in the Response dated 11/28/2007 directed to the rejection set forth under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) in the Non-final Office Action dated 6/28/2007 are deemed moot in light of a new ground of rejection under 35 U.S.C. 103(a) as set forth below in view of applicants amendments and in view of applicants arguments.

Examiner acknowledges applicant's amendments directed to Examiners objection of claim 15 set forth in the Non-final Office Action dated 6/28/2007, which obviate the objection to the claim. Therefore, Examiner withdraws further objection to the claim.

Examiner acknowledges applicant's arguments and amendments of claims 20-22 to resolve indefiniteness of the claims, which obviate the rejections under 35 U.S.C. 112, second paragraph described in the Non-final office action dated 6/28/2007. Therefore, Examiner withdraws further rejection under 35 U.S.C. 112, second paragraph.

Examiner acknowledges that the nonstatutory grounds of the Obviousness-type Double Patenting rejection were not overcome by the applicant because the applicant has not yet filed a terminal disclaimer in anticipation that the provisionally rejected claims shall be amended away from the claims of Rowe et al. (U.S. Patent No. 6,969,319; hereinafter Rowe) during prosecution. However, Examiner finds that applicant's amendment of claim 1 does not overcome the nonstatutory grounds of the Obviousness-type Double Patenting rejection described in the Non-final office action dated 6/28/2007, and further induce a new nonstatutory grounds of Obviousness-type Double Patenting rejection. Therefore, Examiner sets forth a new provisional rejection of claims 1-10 and 13-14 on the ground of nonstatutory obviousness-type double patenting until such time that claims 1-10 and 13-14 are no longer unpatentable over claims 1-2, 5-10, 12-13 and 16-17, respectively, of Rowe.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory

double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 and 13-14 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 5-10, 12-13 and 16-17, respectively, of Rowe et al. (U.S. Patent No. 6,969,319; hereinafter Rowe) in view of Leen et al. (U.S. Patent No. 6,979,267; hereinafter Leen). Although the conflicting claims are not identical, they are not patentably distinct from each other because every element of claims 1-10 and 13-14 are found in claims 1-2, 5-10, 12-13 and 16-17, respectively, in the disclosure of Rowe and Leen.

Claims 1-2, 5-10, 12-13 and 16-17 of Rowe discloses every limitation of claims 1-10 and 13-14 of Application No. 10/661,095 with the exception of substantially reciting that the promotional device is associated with a specific player and that there is information used to identify a specific gaming application. However, Rowe discloses that the cashless instrument or ticket voucher or promotional device contains information about the ticket owner or specific player for registering credits (column 2, lines 60-64 and column 3, lines 10-17, Rowe). Moreover, Leen discloses that a game identifier has information for identifying a gaming application (column 5, lines 4-9, column 12, lines 21-23 and lines 40-43 and Fig. 1, 114, Leen; See also column 5, line 45 to column 6, line 15 and column 7, lines 24-41, Rowe).

Leen suggests that a device that provides enhanced services to users of a gaming application will create an incentive for users to become dedicated to the gaming environment (column 1, lines 11-34 and column 2, lines 35-67, Leen).

Hence, it would have been obvious to one having ordinary skill in the art to modify claims 1-2, 5-10, 12-13 and 16-17 of Rowe to provide a specific player associated with the game-specific credit and information used to identify a specific gaming application as recited in claims 1-10 and 13-14, respectively, of Application No. 10/661,095 because players would have a reason to become dedicated to the gaming environment for playing various games executed by different gaming applications.

The following claim chart shows the claim-to-claim comparison between both the application and patent:

10/661,095	6,969,319
<p>Claim 1: A promotional device for effecting operation of a specific gaming application on a gaming machine, when the specific gaming application is available for play on the gaming machine, that is in communication with the promotional device, the promotional device having associated therewith (the gaming application is a game)</p> <p>1) indicia of credit applicable only to the specific gaming application,</p> <p>2) a specific player to which operation of</p>	<p>Claim 1: A promotional device having indicia of game-specific credit associated therewith for effecting operation of game code corresponding to a specific game on a gaming machine which is in communication with the promotional device, the promotional device having machine-readable information encoded therein which both identifies</p> <p>the indicia of game-specific credit (the game-specific credit is inherently applicable to a specific gaming application since operation of a specific game is effected by the credit) and</p> <p>relates the game-specific credit to the</p>

<p>the specific gaming application and application of the indicia of credit is limited and (the specific player is associated with the game-specific credit that relates to the specific game or game application)</p>	<p>specific game, the gaming machine being operable to employ the machine-readable information to identify the specific game and limit use of the game-specific credit thereto (it would have been obvious at the time of invention that a specific player is associated with the game-specific credit since Rowe teaches that the player uses their cashless instrument to register credits on the gaming machine).</p>
<p>3) information used to identify the specific gaming application.</p>	<p>(it would have been obvious at the time of invention to use information to identify a specific gaming application since Leen discloses that a game identifier has information for identifying a gaming application)</p>
<p>Claim 2: The promotional device of claim 1 further comprising visual elements on the promotional device representing the specific gaming application.</p>	<p>Claim 2: The promotional device of claim 1 further comprising visual elements on the promotional device representing the specific game.</p>
<p>Claim 3: The promotional device of, claim 1 wherein the promotional device is a printed ticket and wherein the indicia of credit is associated with a bar code on the printed ticket.</p>	<p>Claim 5: The promotional device of claim 1 wherein the promotional device comprises a printed ticket and wherein the indicia of credit comprises a bar code on the printed ticket.</p>
<p>Claim 4: The promotional device of claim 3 wherein the bar code also identifies the specific gaming application.</p>	<p>Claim 6: The promotional device of claim 5 wherein the bar code also identifies the specific game.</p>
<p>Claim 5: The promotional device of claim 1 wherein the promotional device is a card having magnetic information stored therein which includes the credit.</p>	<p>Claim 7: The promotional device of claim 1 wherein the promotional device comprises a card having magnetic information stored therein which includes the indicia of credit.</p>
<p>Claim 6: The promotional device of claim 5 wherein the magnetic</p>	<p>Claim 8: The promotional device of claim 7 wherein the magnetic information also</p>

<p>information also identifies the specific gaming application.</p> <p>Claim 7: The promotional device of claim 1 wherein the promotional device is a card having a memory embedded therein which stores information corresponding to the credit.</p> <p>Claim 8: The promotional device of claim 7 wherein the information identifies the specific gaming application.</p> <p>Claim 9: The promotional device of claim 1 wherein the gaming machine is part of a gaming network that includes a remote storage device, at least part of the credit being stored in the remote storage device.</p> <p>Claim 10: The promotional device of claim 9 wherein the promotional device identifies the specific player and the part of the credit stored in the remote storage device that is associated with the specific player.</p> <p>Claim 13: The promotional device of claim 1 wherein the promotional device further comprises a wireless transmitter for communicating with the gaming machine.</p> <p>Claim 14: The promotional device of claim 1 further configured to identify a gaming venue in which the promotional device may be employed (a gaming venue is at least one gaming venue).</p>	<p>identifies the specific game.</p> <p>Claim 9: The promotional device of claim 1 wherein the promotional device comprises a card having a memory embedded therein which stores information corresponding to the indicia of credit.</p> <p>Claim 10: The promotional device of claim 9 wherein the information identifies the specific game.</p> <p>Claim 12: The promotional device of claim 1 wherein the gaming machine is part of a gaming network which includes a remote storage device, at least part of the indicia of credit being stored in the remote storage device.</p> <p>Claim 13: The promotional device of claim 12 wherein the promotional device identifies a user, the part of the indicia of credit stored in the remote storage device being associated with the user.</p> <p>Claim 16: The promotional device of claim 1 wherein the promotional device further comprises a wireless transmitter for communicating with the gaming machine.</p> <p>Claim 17: The promotional device of claim 1 further configured to identify at least one gaming venue in which the promotional device may be employed.</p>
---	--

Examiner incorporates herein by reference the grounds of rejection of the claims under 35 U.S.C. § 102(a) and 35 U.S.C. § 103(a) as described in the Non-final Office Action dated 6/28/2007 because the scope of the claims in the Response dated 11/28/2007 is substantially the same as the scope of the claims examined in the Non-final Office Action dated 6/28/2007 with the exception of certain amended features, and sets forth new grounds of rejection under 35 U.S.C. § 103(a) with respect to amended features as described below because each of the features of applicant's claimed invention as amended continues to be unpatentable or obvious over the prior art.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 5-8, 12, 14-15, 26, 37 and 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarbin et al. (US Patent 5,179,517; hereinafter Sarbin) in view of Leen. Figures are described with reference characters where necessary for clarity.

Regarding claims 1 and 15, Sarbin substantially teaches features of the claimed invention as described in the Non-final Office Action dated 6/28/2007.

However, Sarbin does not substantially teach that the operation of the specific gaming application on a gaming machine is effected when the application is available

for play on the gaming machine, that the indicia of credit is applicable only to the specific gaming application, that there is a specific player to which application of the gaming application and application of the indicia of credit is limited and that there is information used to identify the specific gaming application as claimed. Therefore, attention is directed to Leen, which teaches

operation of a specific gaming application on a gaming machine is effected when the specific gaming application is available for play on the gaming machine (column 12, lines 56-63, column 13, line 65 to column 14, line 17 and Fig. 1, 114, Leen; different gaming applications are executed when a request is made for enhanced services by the player and it would have been obvious at the time of invention to try an implementation in which a certain gaming application is available for play since it is necessary that the one or more of the gaming applications be available in order to be executed by a processor via program software), wherein

1) there is indicia of credit that is applicable only to the specific gaming application (column 5, lines 4-9 and column 11, lines 21-32, Leen; a wager is indicia of credit that is associated with a gaming application and used for execution thereof),

2) there is a specific player to which operation of the specific gaming application and application of the indicia of credit is limited (column 5, lines 4-9 and column 12, lines 23-32 and lines 43-50, Leen) and

3) there is information used to identify the specific gaming application (column 5, lines 4-9, column 12, lines 21-23 and lines 40-43 and Fig. 1, 114, Leen).

Leen suggests that a device that provides enhanced services to users of a gaming application will create an incentive for users to become dedicated to the gaming environment (column 1, lines 11-34 and column 2, lines 35-67, Leen).

Thus, it would have been obvious to one having ordinary skill in the art at the time the applicant's invention was made to modify Sarbin in view of the teachings of Leen for the purpose of providing the gaming device of Sarbin having gaming machine and promotional device features for initiating play of a game on a gaming machine that are interchangeable with or upgradeable to the application available for play operation of the gaming machine, indicia of credit, specific player limitation and application identification features of Leen in order to provide players with a reason or incentive to become dedicated to the gaming environment for playing various games executed by different gaming applications.

Regarding claim 26, the scope of the claim for the method of operating the system would be inherent with respect to claim 15 above in view of the structure disclosed by Sarbin and Leen since the method is the normal and logical manner by which the system could be employed.

Regarding claims 5-8, 12, 14, 37 and 39-40, the claims are rejected for the reasons described above and the reasons described in the Non-final Office Action dated 6/28/2007.

Claims 16-25 and 27-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarbin in view of Leen, and further in view of Saunders et al. (US Patent 6,340,331; hereinafter Saunders).

Regarding claims 16-25 and 27-36, the claims are rejected for the reasons described above and the reasons described in the Non-final Office Action dated 6/28/2007.

Claims 2-4 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarbin in view of Leen, and further in view of Luciano et al. (US Patent 6,500,067; hereinafter Luciano).

Regarding claims 2-4 and 9-11, the claims are rejected for the reasons described above and the reasons described in the Non-final Office Action dated 6/28/2007.

Claims 13 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sarbin in view of Leen, and further in view of Mish (US Patent 6,254,006).

Regarding claims 13 and 38, the claims are rejected for the reasons described above and the reasons described in the Non-final Office Action dated 6/28/2007.

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bergeron (US Patent 4,764,666) in view of Leen.

Regarding claim 41, Bergeron substantially teaches features of the claimed invention as described in the Non-final Office Action dated 6/28/2007.

However, Bergeron does not substantially teach that the operation of the specific gaming application on a gaming machine is effected when the application is available for play on the gaming machine as claimed. Therefore, attention is directed to Leen, which teaches

operation of a specific gaming application on a gaming machine is effected when the specific gaming application is available for play on the gaming machine (column 12, lines 56-63, column 13, line 65 to column 14, line 17 and Fig. 1, 114, Leen; different gaming applications are executed when a request is made for enhanced services by the player and it would have been obvious at the time of invention to try an implementation in which a certain gaming application is available for play since it is necessary that the one or more of the gaming applications be available in order to be executed by a processor via program software).

Response to Arguments

Applicant's arguments filed in the Response dated 11/28/2007 with respect to Examiners' rejection under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) have been

considered fully and are moot in light of a new ground of rejection under 35 U.S.C. 103(a) as set forth above in view of applicant's amendments and in view of applicant's arguments thereof.

Examiner has provided the above new grounds of rejection of the claims under 35 U.S.C. 103(a) because each of the features of applicant's claimed invention continues to be unpatentable or obvious over the prior art.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

B US-7,162,036 B2, Rowe

C US-2002/0111210 A1, Luciano, Jr. et al.

D US-6,264,561 B1, Saffari et al.

E US-6,679,775 B1, Luciano et al.

F US-2004/0023711 A1, Knapp

G US-6,729,956 B2, Wolf et al.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur O. Hall whose telephone number is (571) 270-1814. The examiner can normally be reached on Mon - Fri, 8:00am - 5:00 pm, Alt Fri, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/
Supervisory Patent Examiner, Art
Unit 3714

/A. O. H./
Examiner, Art Unit 3714
1/28/2008